

P01018US1A(P291)

**REMARKS**

The Decision of the Board of Patent Appeals and Interferences dated August 31, 2004, contained a new ground of rejection pursuant to 37 C.F.R. § 1.96(b) (2003). This new ground of rejection is not considered final for purposes of judicial review. In view thereof, Appellant, within two months from the date of the Decision, may submit an appropriate amendment of the claims so rejected, or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the application will be remanded to the Examiner. This response and amendment is being filed accordingly.

Subsequent to the Decision of August 31, 2004, by the Board of Patent Appeals and Interferences, the Examiner issued a Notice of Abandonment dated September 28, 2004. Appellants attorney and the Examiner conducted a telephone interview on October 19, 2004, wherein the Examiner indicated that the Notice of Abandonment had been issued in error and that a Response and Amendment would be considered.

Within its Brief, Appellant argued the independent basis of patentability of claims 2, 21, and 22 based upon the fact that Kline<sup>1</sup> teaches relatively low amounts of the DAAMP compound:

[t]he level of the DAAMP compound will vary depending upon the amount of catalyst used in preparing the polymer. The amount of DAAMP is normally from one mole to five moles per mole of transition metal in the catalyst,<sup>2</sup>

whereas claims 2, 21, and 22 call for greater amounts of the DAAMP compound. Namely, claim 2 recited "from about 0.1 to about 10 parts by weight per 100 parts by weight syndiotactic 1,2-polybutadiene" of the antioxidant, claim 21 recites "from about 0.2 to about 5 parts by weight per 100 parts by weight of the syndiotactic 1,2-polybutadiene" of the antioxidant, and claim 22 recites "from about 0.5 to about 3 parts by weight per 100 parts by weight of the syndiotactic 1,2-polybutadiene" of antioxidant.

Kline, however, teaches that the amount of DAAMP compound employed is a function of the amount of transition metal, whereas previously pending claims 2, 21, and 22 recited the amount of antioxidant as a function of the amount of polymer.

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<sup>1</sup> U.S. Patent No. 3,935,160.

<sup>2</sup> Column 4, lines 23-27.

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Accordingly, if one were to apply the teachings of Kline to the teachings of Luo<sup>3</sup>, the amount of DAAMP compound employed could vary widely based upon the amount of metal within the polymer compositions of Luo. Notably, if the polymers of Luo were produced by inefficient polymerization procedures, which would thereby result in lower yields, then the amount of transition metal as a function of polymer would be higher, which would result in higher levels of damp compound if the teachings of Kline were followed.<sup>4</sup>

In view of the foregoing, the undersigned attorney and Examiner Lee conducted a series of telephone interviews or telephone conferences during the week of October 25, 2004. Applicant and Applicants' attorney believe that these teleconferences can be accurately summarized by stating that Applicants and the Examiner agreed that recitation to the amount of residual transition metal within the polymer composition and a corresponding amount of antioxidant could define over the combination of Kline and Luo so long as the ratio of transition metal to antioxidant is greater than that taught by Kline (i.e., greater than 1:5). As part of these teleconference/telephone interviews, Applicants' attorney and the Examiner discussed the fact that this ratio could vary based on the molecular weight of the antioxidant, and therefore the amended claims take this into account. Further, Applicants' attorney and the Examiner discussed the amendment to the written description whereby material incorporated by reference has been added. Applicants believe that the claims, as now amended, reflect the discussions that were held between Applicants' attorney and the Examiner.

Moreover, Applicants believe that their invention, as now set forth in the pending claims, is patentable over both Kline and Luo alone or in combination. In particular, Applicants believe that they have rebutted any prima facie case of obviousness that may have existed by more precisely defining the ratio of transition metal to antioxidant.

Appellants note that various amounts or ranges of transition metal present within the composition can be found in several of the patent references incorporated by reference on page 9 of the written description. The relevant portions of these patent references have been incorporated at page 9 pursuant to the amendment to the written description set forth above. Particularly, Appellants have incorporated a disclosure from

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<sup>3</sup> U.S. Patent No. 6,117,956.

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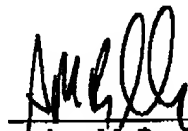
U.S Patent no. 6,465,585 at column 12, lines 4-20 (U.S Serial No. 09/788,795), U.S Patent Nos. 6,211,313 at column 9, lines 28-51, and U.S Patent No 6,303,692 at column 16, lines 1-21 (U.S Serial No. 09/878,026).

### CONCLUSION

Accordingly, Appellant believe that they have appropriately defined their invention and that the claims are now allowable over the combination of Kline and Luo. A formal Notice of Allowance of claims 36 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

No fees are believed due with the filing of this document, nonertheless, in the event that a fee required for the filing of this document is missing or insufficient, the undersigned attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication or to credit any overpayment to Deposit Account No. 06-0925.

Respectfully submitted,



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November 1, 2004

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\* See paragraph (C) [page 10] of Examiner's Answer dated December 2, 2003.